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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,804	12/10/2004	Kenji Adachi	3019.010USU	8937

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OHLANDT, GREELEY, RUGGIERO & PERLE, LLP  
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STAMFORD, CT 06901

EXAMINER
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DEES, NIKKI H

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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12/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/517,804	<b>Applicant(s)</b> ADACHI ET AL.	
	<b>Examiner</b> Nikki H. Dees	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>30 June 2008, 24 October 2008</u> .                           | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 24, 2008, has been entered.
2. Claims 1-13 are currently pending in the application. The previous 35 USC 103 rejection of claims 1-13 over Banks in view of Crawford et al., WHO, Torres et al., or Chang has been withdrawn in view of Applicant's amendments to claims 1-7, 12, and 13.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 is vague and indefinite. Lines 2-3 of the claim recite an inhibitor comprising an extract of semi-fermented tea leaves or fermented tea leaves. However, lines 5-6 of the claim exclude "an inhibitor for the quality deterioration of a coffee liquid extract" comprising "an extract obtained by extracting... semi-fermented tea leaves or fermented tea leaves." The claim contains contradicting limitations and it is not clear what applicant intends to exclude or include. For prior art rejections, the claims are interpreted to include extracts of fermented tea leaves or semi-fermented tea leaves.
6. Claims 2-6 have the same problem as claim 1 with respect to the contradicting limitations.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Park et al. (Park, J.C., Park, J.G., Kim, H.J., Hur, J.M., Lee, J.H., Sung, N.J., Chung, S.K., Choi, J.W. 2002. "Effects of Extract from *Angelica Keiskei* and its Component, Cynaroside, on the Hepatic Bromobenzene-metabolizing Enzyme System in Rats. *Phytotherapy Research*. Vol. 16. pp. S24-S27).

9. Park et al. teach an extract obtained by extracting ashitaba (*Angelica keiskei*) with methanol, a polar solvent (p. S24).
10. Applicant's claims to the extract as a "flavor deterioration inhibitor", and "inhibitor for the generation of deterioration smell of citral..." are considered to be statements of intended use. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). MPEP § 211.02 (II).
11. In the instant claims, the extract of ashitaba with a polar organic solvent is taught in the prior art. Therefore, Applicant's claims 1, 2, and 7 are considered to be anticipated by the teachings of Park et al.
12. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Mai et al. (US 4,839,187).
13. As claims 1-6 are indefinite for the reasons set forth above, for the prior art rejection, the claims are interpreted to include extracts of fermented tea leaves or semi-fermented tea leaves.
14. Mai et al. teach an antioxidant composition comprising an aqueous extract from black (fermented) tea leaves (Abstract).

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15. As discussed in the 102 rejection over Park et al., the preamble statements of intended use are not considered to be limiting. Therefore, the teachings of Mai et al. anticipate Applicants claims 1, 2, and 7.

16. Regarding claims 3-6, the extract is taught to function as an antioxidant in foodstuffs containing lipids (Abstract). One of ordinary skill would recognize that oxidation of lipids results in off-flavors. Therefore, the composition of Mai et al. is considered to be a flavor deterioration inhibitor. The composition is taught to be added to foodstuffs in an amount ranging from 0.008 to 1.0 wt % (col. 3 lines 6-10). Foodstuffs to which the composition may be added include fats and oils, noodles, and mayonnaise (col. 2 lines 4-9). The foodstuffs including fats and oils and mayonnaise are also considered to be flavors to be added to foods. The teachings of Mai et al. therefore anticipate Applicant's claims 3-6.

17. Claims 1-4, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hara et al. (4,673,530).

18. Hara teaches an antioxidant composition comprising extract obtained by extracting semi-fermented tea leaves with a solvent including water or a mixture of water and polar organic solvents (Abstract; col. 1 lines 61-63).

19. As discussed in the 102 rejection over Park et al., the preamble statements of intended use are not considered to be limiting. Therefore, the teachings of Hara anticipate Applicants claims 1, 2, and 7.

20. Hara teaches the composition added to lard, an oral composition, at 10-20 ppm to prevent oxidation (col. 3 lines 31-38). These teachings anticipate Applicant's claims 3 and 4.

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bank et al. (WO 98/58656) in view of Mai et al. (US 4,839,187).

23. Bank et al. teach a citral flavor deterioration inhibitor (or stabilizing agent) (abstract) in the form of a water-soluble plant extract (p. 5 lines 22-24). They also teach a storage stable food composition with a citrus flavor that includes this extract (claim 16).

24. Bank et al. add the plant extract inhibitor to their composition at a concentration ranging from about 10 ppm to 500 ppm (claim 15).

25. Bank et al. teach that their extract inhibits the formation of the citral oxidative degradation product *p*-methylacetophenone (p. 5 lines 1-3).

26. Bank et al. are silent as to the use of an extract from ashitaba, semi-fermented tea leaves, or fermented tea leaves. They also do not speak specifically to the use of their composition in fragrances and cosmetics.

27. Mai et al. teach an aqueous tea extract that is used as an antioxidant (Abstract). They further state that their invention has antioxidant activity similar to that of products obtained from rosemary, while also having a less intense flavor (col. 1 lines 49-51).

28. It would have been obvious to one of ordinary skill in the art at the time the invention was made to try an extract from tea known to be an effective antioxidant, as taught by Mai et al., for the rosemary extract of Bank et al. in order to provide a citral containing product protected from flavor deterioration. As both the product of Bank et al. and the product of Mai et al. were known in the prior art to be effective for the same purpose (as antioxidants), one of ordinary skill would have found it obvious to utilize a known antioxidant with a less intense flavor where an antioxidant derived from rosemary was previously utilized. This would not have required undue experimentation, and there would have been a reasonable expectation that the composition of Mai et al. would have functioned effectively to inhibit the flavor deterioration as taught by Bank et al.

29. Regarding claim 11, one of ordinary skill in the art would have found it obvious to utilize known antioxidant to compositions wherein antioxidative protection is desired. As the combination of Bank in view of Mai is suitable for addition to foodstuffs, one of ordinary skill would have had found it obvious to incorporate in compositions including fragrances and cosmetics that may come in contact with skin to minimize the possibility of adverse effects on the user of the fragrance or cosmetic.



30. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bank et al. (WO 98/58656) in view of Hara (4,673,530).

31. Bank et al. teach a citral flavor deterioration inhibitor (or stabilizing agent) (abstract) in the form of a water-soluble plant extract (p. 5 lines 22-24). They also teach a storage stable food composition with a citrus flavor that includes this extract (claim 16).

32. Bank et al. add the plant extract inhibitor to their composition at a concentration ranging from about 10 ppm to 500 ppm (claim 15).

33. Bank et al. teach that their extract inhibits the formation of the citral degradation product *p*-methylacetophenone (claim 24).

34. Bank et al. are silent as to the use of an extract from ashitaba, semi-fermented tea leaves, or fermented tea leaves. They also do not speak specifically to the use of their composition in fragrances and cosmetics.

35. Hara teaches an aqueous tea extract that is used as an antioxidant (Abstract; col. 1 lines 61-63). The composition is taught for use in foodstuffs, as well as in cosmetics (col. 2 lines 59-64).

36. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted an extract from tea known to be an effective antioxidant, as taught by Hara, for the rosemary extract of Bank et al. in order to provide a citral containing product protected from flavor deterioration. As both the product of Bank et al. and the product of Hara were known in the prior art to be effective for the

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same purpose (as antioxidants), one of ordinary skill would have had a reasonable expectation the extract of Hara would have functioned effectively as an antioxidant to inhibit citral flavor degradation in the invention of Bank et al. Substituting a known ingredient for a known alternative ingredient which performs the same function would have been obvious to one skilled in the art. One skilled in the art would have been motivated to substitute the tea extract for the rosemary extract of Bank et al. when desiring a less intense flavor. Rosemary extracts are known in the art to have an intense flavor as shown in the Mai reference above.

### ***Response to Arguments***

37. Applicant's arguments filed October 24, 2008, have been fully considered but are moot in view of Applicant's amendments to claims 1-7, 12, and 13.

### ***Conclusion***

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mai et al. (4,891,231) also teaches an antioxidant composition comprising an aqueous tea extract.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-

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3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST  
(second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lien Tran/  
Primary Examiner  
Art Unit 1794

Nikki H. Dees  
Examiner  
Art Unit 1794